

REMARKS

Reconsideration of the present application, as amended, is respectfully requested.

A. STATUS OF THE CLAIMS

As a result of the present amendment, claims 1-6, 8, 10-14, 16-26 and 33 remain for continued prosecution.

Claim 1 has been amended to recite that R₁ and R₂ are linear, branched, or multi-armed polyalkylene oxides. Support for the amendment can be found, for example, in paragraph [0025] on page 12, lines 17-21 of the specification and in original claim 9.

Additionally, claim 1 has been amended to remove the term “residue” for the definitions of Q_a and Q_b groups.

Claim 9 has been cancelled without prejudice. Accordingly, claims 10-14 as amended herein depend from claim 1, not cancelled claim 9.

Claim 11 has been amended to include embodiments of the capping group A. Support for the amendment can be found, for example, in paragraphs [0021]-[0022] on pages 9-10 and paragraph [0025] on pages 12-13.

Claim 16 has been amended to correct dependency to claim 1 from cancelled claim 15.

Applicants noted that amendments to claim 21 were provided in the previous amendment of December 5, 2007 to correct some informalities, but the claim identifier of the claim was improperly indicated as “Previously Presented”. In order to clarify the proposed amendments to claim 21, it has been amended to correct the informalities and indicate that it is “Currently Amended”.

No new matter has been added.

B. CLAIM REJECTIONS UNDER 35 USC § 112, SECOND PARAGRAPH

At pages 2-4 of the Office Action, claims 9-14, 19, 20-23 and 26 are rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite.

With respect to claim 9 and dependent claims 10-20, the Examiner maintained the rejection that there is insufficient basis for the recitation of “multi-armed polyalkylene oxide” in claim 9. The Examiner indicated that a “linear” polyethylene glycol is claimed in claim 1. Similarly, the Examiner rejected claims 21-23 and 26.

Without admitting the appropriateness of the Examiner's position and for facilitating prosecution, the definitions of R_1 and R_2 in claim 1 have been amended to recite that R_1 and R_2 are linear, branched, or multi-armed polyalkylene oxides. Support for the amendment can be found, for example, in paragraph [0025] on page 12, lines 17-21 of the specification. As such, claim 1 as amended herein provides proper basis for those rejected claims.

The amendments made herein to the claims have been made in an effort to expedite the prosecution of the present application rather than indicate that the rejections made by the Examiner are accepted or as an admission of the soundness of the rejection made by the Examiner.

As a result of the amendment to claim 1 and reasons set forth above, it is respectfully submitted that all of the issues mentioned on pages 2-4 of the Office Action are fully addressed. Reconsideration and removal of the rejection is respectfully requested.

C. CLAIM OBJECTIONS

At page 4 of the Office Action, the Examiner required correction for the informalities contained in claims 16-18. The claims are objected to because the claims depended from cancelled claim 15. In response, Applicants with appreciation have amended the claims to depend from claim 1, rendering the objections moot.

D. CLAIM REJECTIONS UNDER 35 USC § 112, SECOND PARAGRAPH

At pages 4-5 of the Office Action, claims 1-8, 11 and 33 are rejected under 35 USC 112, second paragraph, as allegedly indefinite.

With respect to claim 1, the Examiner indicated that the term "residue" for Q_a and Q_b is not clear. In response, the term has been removed from claim 1, rendering the rejection moot.

Concerning the Examiner's comments on the capping group in claims 3 and 11, the Examiner suggested incorporating embodiments of the capping group J into the claims. Applicants assume that the Examiner intended to suggest incorporating embodiments of the capping group "A", which is defined as "J" in paragraph [0025] on pages 12-13 of the specification, into claim 11 because pending claim 3 recites embodiments of the capping group J.

In response, claim 11 has been amended to include embodiments for the capping group J. Support for the amendment can be found, for example, in paragraphs [0021]-[0022] on pages 9 and 10; in paragraph [0025] on pages 12-13 of the specification; and in claims 2 and 3.

Accordingly, reconsideration and removal of the rejection is respectfully requested.

E. CLAIM REJECTIONS UNDER 35 USC § 112, FIRST PARAGRAPH

At pages 5-6 of the Office Action, claims 9-20 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The Examiner indicated that there is lack of written description for the claimed “multi-armed polyalkylene oxide” because the essential material referred to by the term was incorporated by way of journal reference.

Applicants respectfully disagree.

Claim 1 as amended herein includes the term “multi-armed” polyalkylene oxide. Contrary to the Examiner’s position, the specification provides sufficient description to the term, “multi-armed” polymer. The specification includes representative formulas of multi-armed polymers. See the four formulas of multi-armed polymers described in [0026] on page 14 of the specification. The first three formulas describe a polymer having a pentaerythritol core attached to four linear polymer strings. The multi-arm polymer having the pentaerythritol and four polymer strings are referred to as “Star PEG” in the art. The fourth formula represents a polymer having a glycerin core attached to multiple polymer strings such as, but not limited to, 4, 6, 8, 16 or 32 arms, preferably, 4 or 8 arms when (m) of the formula is zero or 4.

The Examiner noted that the Nektar Corporation’s 2003 catalog entitled “Polyethylene Glycol and Derivatives for Advanced PEGylation” was incorporated by reference in [0035] on page 21 of the specification. The catalog shows the several commercially available multi-arm polymers under the section heading “Multi-arm PEGs”. See page 5 of the Shearwater Corporation’s 2001 catalog entitled “Polyethylene Glycol and Derivatives for Biomedical Applications” (Exhibit 1) and page 26 of the Nektar Corporation’s 2006 catalog (Exhibit 2). Please note that Nektar Corporation was formally Shearwater Corporation. The descriptions contained in the catalog are consistent with those contained in the specification. As such, the essential material, “multi-armed” polymeric portion is described in the specification and also referred to by the reference.

The catalogs confirm that the term “multi-armed” polyalkylene oxide is term of art. Accordingly, those of ordinary skill in the art appreciate structures of “multi-armed” polyalkylene oxide contemplated within the scope of the invention in light of the descriptions in the specification and known in the art as evidenced by the Nektar catalog.

For the reasons set forth, reconsideration and removal of the rejection is respectfully requested.

F. ALLOWABLE SUBJECT MATTER

Applicants note with appreciation that the Examiner has indicated that claims 24-25 include allowable subject matter. Applicants respectfully urge that in view of the current amendment, all of the currently examined claims are in condition for allowance.

G. FEES


This response is being filed with a petition for a two-month extension of time and the required fee via credit card authorization. Thus, no further fee is believed to be required. If, on the other hand, it is determined that any further fees are due or any overpayment has been made, the Assistant Commissioner is hereby authorized to debit or credit such sum to deposit account 02-2275. Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.

H. CONCLUSION

In view of the actions taken and arguments presented, it is respectfully submitted that each and every one of the matters raised by the Examiner have been addressed by the present amendment and that the present application is now in condition for allowance.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,
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